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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,592

03/24/2004

Gregory C. Franke

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04/14/2006

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/807,592

Applicant(s)

FRANKE ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-26, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-18 is/are allowed.
- 6) ☒ Claim(s) 1-8, 19, 22-26 and 32 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claim 31 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 8/10/2005.

A complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Specification***

2. The amendment filed 2/2/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The specific lack of a sleeve. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed was completely silent on

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whether or not a sleeve was part of the invention -- the word "sleeve" is never disclosed.

Thus there is no written description support for the sleeve being excluded. Thus Per

MPEP 2173.05(i): (emphasis by examiner)

*MPEP 2173.05(i) Negative Limitations*

*The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).*

*A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. In re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).*

***Any negative limitation or exclusionary proviso must have basis in the original disclosure.*** If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). ***The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.*** Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sihon USP 5397206.

Sihon teaches a fastener comprising an integrated isolation member 28 composed of resilient material (abstract-rubber grommet), capable of isolating a storage drive and capable of fitting within a slot of the drive cage and abutting a drive cage surface. There is an outer wall and axial portion - see Fig 1. If "12" were the drive cage, "46" would be the ribs which invert and abut a drive cage surface - see Fig 1 to 2 to abutment.

**rib** (rib) *noun*

2. A part or piece similar to a rib and serving to shape or support: *the rib of an umbrella*.<sup>1</sup>

Threaded fastener (22/20) is shown in the Figures, and has a head capable of tightening the fastener, and a washer (34) upon which the isolation member is provided, located between the head and threaded stud. A shaft (30) extends between head and threaded stud, and the washer is mounted on and contacts the shaft the shaft (Figures).

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<sup>1</sup>Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from Lernout & Hauspie Speech Products N.V., further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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7. Claims 1-3, 5-8, are rejected under 35 U.S.C. 102(b) as being anticipated by Antoine et al USP 6227784.

Antoine et al teaches a fastener comprising an integrated isolation member composed of resilient material, capable of isolating a storage drive and capable of fitting within a slot of the drive cage and abutting a drive cage surface. Col 2 lines 57-67 teach an isolation member made of thermoplastic elastomeric material.

8. Claims 1,3, 5-8, 32, are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al USP 6917520.

Lin teaches a fastener comprising an integrated isolation member (Fig 1) composed of a resilient material (body 34 described as compressed in abstract, and since it is described as for absorbing shock, it is inherently resilient). It is capable of fitting within a drive cage slot (Fig 3 - unit 1/10/20/30 could clearly fit in a slot) and it would abut a cage surface when so engaged. It has an outer wall and axial portion (Fig 1) and threaded stud (16), head (10's surface 1--see Fig 3) and shaft (15)-mounted washer (20) between head and stud. Lin does not teach a sleeve as required.

***Claim Rejections - 35 USC § 103***

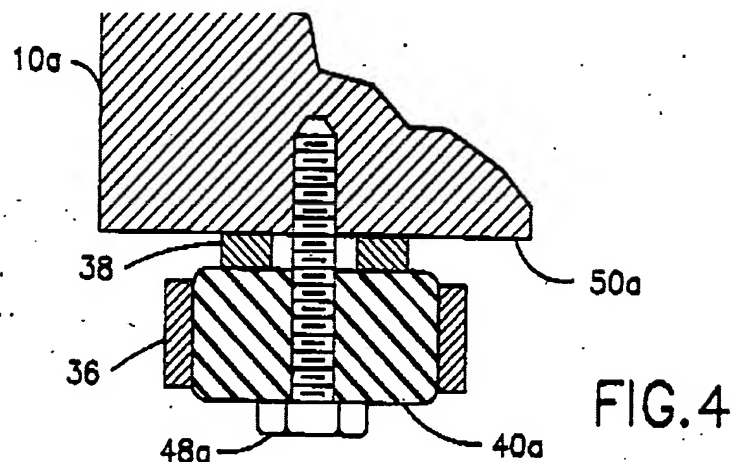
9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felcman et al USP 6122173 in view of Grassens et al USP 4683520.

Re 19, 23,24: Felcman teaches a drive 40 with an outer housing 12 with slots (Fig 2A and 2B) and fasteners 50 mounted to the ends of the drive. Felcman teaches a storage media drive, (Fig 2A and 2B) with the outer housing defining the ends of the drive.

However, the fasteners are not taught as having a resilient or elastomeric isolation member or having a washer mounted on the shaft between the head and stud. Grassens teaches fasteners with resilient isolation members in Figs 1 and 2, and col 2 lines 30-41 teach that resilient isolation members are well known to be used to absorb shock and vibrations for mounting electrical apparatus to a chassis, and col 2 lines 30-41 are specific that a washer can be used such that a resilient isolation member is provided on the washer between the washer and the head when the mounting surface is irregular or resilient. Note that "36" is NOT considered part of the Grassens fastener or the modified Felcman/Grassens fastener. The isolation member includes an outer wall and an axial portion. Were the fastener 50 of Felcman modified per Fig 4 of Grassens, (excluding "36" which would not be part of the modified fastener), the outer wall would be capable of abutting the drive cage surface and the axial portion would fit within the drive cage slot. The metal head, shaft, and threaded stud are a single unit (screw), and the threaded stud is considered the part as labeled below:



Washer 38 is in contact with the shaft via its contact with intermediate member 40a. Absent any further limitation, the washer axial portion is approximately the same diameter as the outer head diameter. Examiner takes Official Notice that it is old and well known in the art to have resilient isolation members made of thermoplastic elastomers to dampen vibrations, and to have a fastener head selected from commonly used fastener heads to coordinate with existing drivers.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Felcman and Grassens before him at the time the invention was made, to modify Felcman in view of Grassens to include the resilient isolation member of Grassens, in order to obtain shock and vibration dampening. One would have been motivated to make such a combination because computer drives are subject to such shock and vibrations, which can damage the devices without a means to minimize the shock and vibrations.

Further Re claim 22: "50' of Felcman is described as a screw head (col 7 lines 1-14), thus clearly there were openings for the fasteners to be threaded into since only the head is visible.



Further Re claims 25-26: The type of drive, including magnetic hard drive or optical drive, is taught by Felcman in col 3 lines 42-53.

***Response to Arguments***

11. Applicant's arguments filed 2/2/2006 regarding rejections over Sihon, Antoine, or Lin have been fully considered but they are not persuasive. Applicant argues that "adapted to" imparts structural limitations, not just intended use. Examiner's structure is capable of fitting within a slot of indeterminate and unclaimed size and abutting a surface of some orientation and size, also not claimed. Applicant clearly claims "A fastener", not a storage drive including a fastener. A fastener does not include a storage media drive, a drive cage, or a slot, and thus these are dependent on the intended use of the fastener structure. The "adapted to" statement does not define any structure and accordingly cannot serve to distinguish.

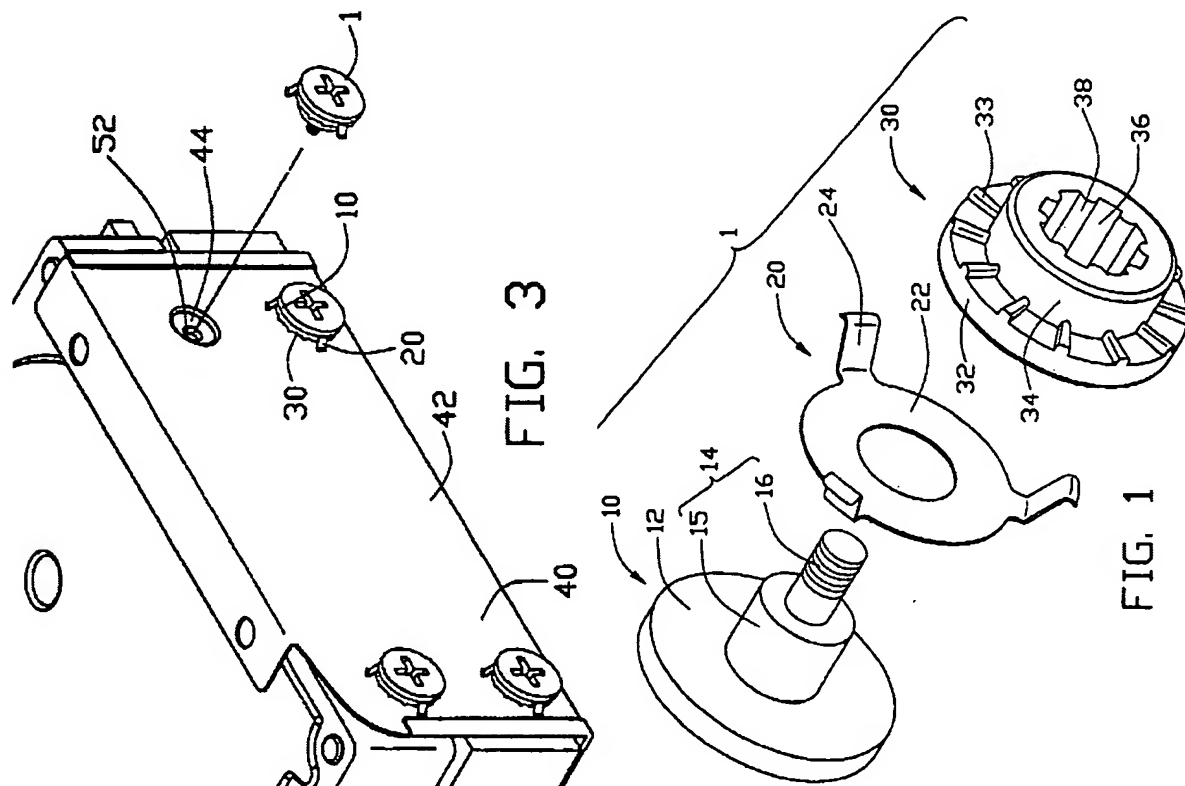
12. Applicant argues that Sihon, Antoine, or Lin is not "sized and configured" to fit in {an unclaimed} drive cage slot. How does one know the size of the unclaimed slot? Surely drive cage slots in mainframes of the 1960's are of different size than those of 2006, which are likely different than those which may be present in 2016. Applicant appears to want the limitations of the drive cage slot and surface without the limitation of requiring the drive cage slot and surface, which is impermissible.

***Allowable Subject Matter***

13. Claims 9-18 are allowed.

14. Claims 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Examiner is well aware that Lin teaches a resilient structure looking like that of applicant, and that it would be possible to combine that with a screw and orient it as described by applicant (the opposite of the orientation of Lin), and that this in combination with Felcman would result in applicant's structure.



However, examiner can find no motivation other than hindsight for such a combination, especially considering that the glides that examiner is familiar with, including her old kitchen cabinet drawers, normally have the larger diameter portion of the resilient member enclosed by the slot, to prevent displacement, rather than the narrower portion

in the slot and the wider portion against the sides of the device being inserted. Thus the combination is not obvious.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell  
Primary Examiner  
Art Unit 3677

Kwm  
4/11/2006

A handwritten signature in black ink, appearing to read 'K Mitchell', is written over the printed name of the examiner.